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JAN 29 2004

OFFICE OF PETITIONS

In re Application of
Vazquez

Application No. 09/459,182

Filed: 7 December, 1999

Attorney Docket No. (None)

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ON PETITION

This is a decision on the petition filed on 12 November, 2003, to revive the above-identified application under 37 C.F.R. §1.137(a)

For the reasons set forth below, the petition under 37 C.F.R. §1.137(a) is **DISMISSED**.

NOTES:

- (1) Any petition (and fee) for reconsideration of this decision under 37 C.F.R. §1.137(a) (as to unavoidable delay) or an alternative request for relief under 37 C.F.R. §1.137(b) (as to unintentional delay) must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)"; and/or "Petition under 37 C.F.R. §1.137(b)";
- (2) Thereafter, there will be no further reconsideration of this matter.

- (3) The record suggests Petitioner's lack of familiarity with practice before the Office. Petitioner may wish to retain the services of a registered practitioner to assist Petitioner in his efforts.¹

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the Notice of Missing Parts mailed on 19 March, 2003, with a reply due (absent a request and fee for extension of time) on or before 19 May, 2003;
- as a result, the application was deemed abandoned after midnight 19 May, 2003;
- notably, a Motion to Withdraw as Counsel of Record (which contained a conflicting and incorrect address for the Applicant/Petitioner herein as 28001 Madrid (in central Spain) while the correct address for Applicant/Petitioner herein was 36310 Vigo Pontevedra (on the Atlantic coast of Spain)) was filed on 31 March, 2003, and granted on 5 May, 2003;
- Notice of Abandonment was mailed on 10 October, 2003;
- Petitioner filed the instant petition *pro se* under 37 C.F.R. §1.137(a) stating and evidencing (with a formal doctor's certificate and translation) illness as the basis of his unavoidable delay, however, the certificate and translation do not address the time period of Petitioner's illness;
- moreover, Petitioner failed to file/pay the petition fee (US\$55.00) and provide the reply (the filing fee for the Continued Prosecution Application (now US\$385.00)), which are requirements for a grantable petition under 37 C.F.R. §1.137(a).

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the

¹ Petitioner may identify registered practitioners in her area by going to the Office website, www.uspto.gov, and clicking on the "Patents" button, then in the "Reference" column clicking on "Roster of Patent Attorneys and Agents." At the "Attorney/Agent" search, Petitioner can insert the name his community or a neighboring major community to identify local registered practitioners.

satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).²

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.³ Delays in responding properly raise the question whether delays are unavoidable.⁴ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁵

And the Petitioner must be diligent in attending to the matter.⁶ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁷))

Petitioner has failed to:

- make a showing of unavoidable delay by evidencing the dates of his illness that might be applicable to the delay, the required showing under the regulation;

² 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

³ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁴ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

⁵ See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁶ See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

⁷ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared and/or deposited for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely prepared and/or deposited for shipment.

- pay the petition fee; and
- submit the required reply.

Accordingly, in view of the record, the petition as considered under 37 C.F.R. §1.137(a) hereby is **dismissed** for failing to satisfy the “showing,” “fee” and “reply” requirements.

ALTERNATIVE VENUE

If Petitioner is unable to make a showing of unavoidable delay surpassing that tendered heretofore, Petitioner's only alternative to irretrievable abandonment likely is to file a petition and fee as set forth at NOTE 1, above at page 1, under 37 C.F.R. §1.137(b), and state therein that “the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional.”

Thus, Petitioner may wish to supplement his petition to plead alternatively under 37 C.F.R. §1.137(b) wherein the “showing ” burden is much less onerous, however, Petitioner must note that as of this writing the petition fee is US\$665.00.

Petitioner is cautioned that failure to submit such a petition 37 C.F.R. §1.137(b) timely may be viewed as intentional delay and an absolute bar to revival.

Further correspondence with respect to this matter should be addressed as follows:

By mail: (Effective 1 May, 2003)⁸
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 872-9306
ATTN.: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

⁸ To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

A handwritten signature in black ink, appearing to be "John J. Gillon, Jr.", written in a cursive style.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions